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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,509	01/26/2001	Kazuhisa Hayakawa	080542/0155	6118

23428 7590 05/09/2003  
FOLEY AND LARDNER  
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WASHINGTON, DC 20007

EXAMINER	
SHEWAREGED, BETELHEM	
ART UNIT	PAPER NUMBER

1774

DATE MAILED: 05/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/769,509	HAYAKAWA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Betelhem Shewareged	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 20 February 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,9,10,17 and 18 is/are rejected.
- 7) Claim(s) 3-8,11-16 and 19 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's submission of Request for Continued Examination (RCE) has been fully considered. All rejections have been withdrawn in view of applicant's amendments and comments.
2. Claims 1, 18 and 19 are amended, and claims 1-19 are pending.

#### ***New Rejections***

##### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 9, 10, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Breckwoldt (US 5,166,333).

Breckwoldt discloses a transparent methyl hydroxypropyl cellulose ether film (abstract and col. 4, lines 5-13 and lines 33-35). Applicant recites in the rejected claims 1, 2, 17 and 18 that the claimed film is used for directly printing on the film and that an ink jet printer is used for printing on the film. However, an apparatus used for printing on the film and an intention of printing on the film are not given patentable weight because applicant is neither claiming an apparatus for printing on the film nor claiming a film having a printed matter directly printed on the film.

5. Claims 1, 2, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Koch et al. (US 3,899,452).

Koch discloses a self-supporting cellulose ether film, wherein the cellulose ether is preferably hydroxyethyl cellulose ether or hydroxypropyl cellulose ether (abstract and col. 1, line 38). Applicant recites in the rejected claims 1 and 2 that the claimed film is used for directly printing on the film and that an ink jet printer is used for printing on the film. However, an apparatus used for printing on the film and an intention of printing on the film are not given patentable weight because applicant is neither claiming an apparatus for printing on the film nor claiming a film having a printed matter directly printed on the film.

6. Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Koch (US 3,840,395).

Koch discloses a fibrous, non-fibrous or a combination of fibrous and non-fibrous cellulosic sheet made of hydroxyethyl cellulose ether (abstract and col. 1, lines 39 and 54). Applicant recites in the rejected claims 1 and 2 that the claimed film is used for directly printing on the film and that an ink jet printer is used for printing on the film. However, an apparatus used for printing on the film and an intention of printing on the film are not given patentable weight because applicant is neither claiming an apparatus for printing on the film nor claiming a film having a printed matter directly printed on the film.

***Allowable Subject Matter***

7. Claims 3-8, 11-16 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The closest arts Breckwoldt (US 5,166,333), Koch et al. (US 3,899,452) and Koch (US 3,840,395) neither teach nor suggest a cellulose ether film, wherein the cellulose ether is characterized in that, in 2 ml of an aqueous solution obtained by mixing 0.1 part by weight of the cellulose ether with 99.9 parts by weight of water at 20°C, the number of undissolved fibers having a length of 8 to 200 um is not greater than 1,000, and wherein said cellulose ether is characterized in that, when 100 g of the cellulose ether is shaken on a sieve having an opening of 150 um, the amount of cellulose ether remaining on the sieve is not greater than 25% by weight.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

BS   
May 2, 2003.